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| 09/872,563      | 06/01/2001  | Eiji Imai            | 500615.20139        | 2695             |

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| EXAMINER         |
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|          |              |
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| ART UNIT | PAPER NUMBER |
| 1734     |              |

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/872,563

Applicant(s)

IMAI ET AL. *mt*

Examiner

Jerry A. Lorengo

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1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

(1)

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2 and 3-5<sup>1</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,697,297 to Rasmussen in view of U.S. Patent No. 5,163,368 to Pensavecchia et al. or U.S. Patent No. 4,852,485 to Brunner.

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<sup>1</sup> Note to Applicant: Claims 3-5 are drawn to functional limitations which place no structural limitations on the apparatus as claimed. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus shows all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) Furthermore, "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666,667 (Bd.

Regarding applicant claim 1, Rasmussen et al. disclose a document printing device comprising (Figures 1A and 1B; column 3, line 46 to column 4, line 38):

- (1) A document creation portions (printing presses) A,B,C,D and E capable of creating a document (printed material) on a medium 6;
- (2) A hot stamp transferring portion (foil relief printer) F capable of providing a transferred foil design on the printed medium 6; and
- (3) A transporting means (not shown) capable of transporting the medium 6 through the document creating and hot stamp transferring portions of the device. The device of Rasmussen et al. is illustrated below:

FIG. 1A

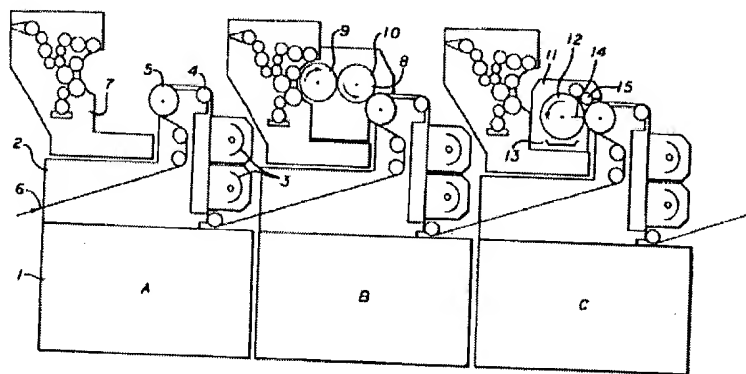
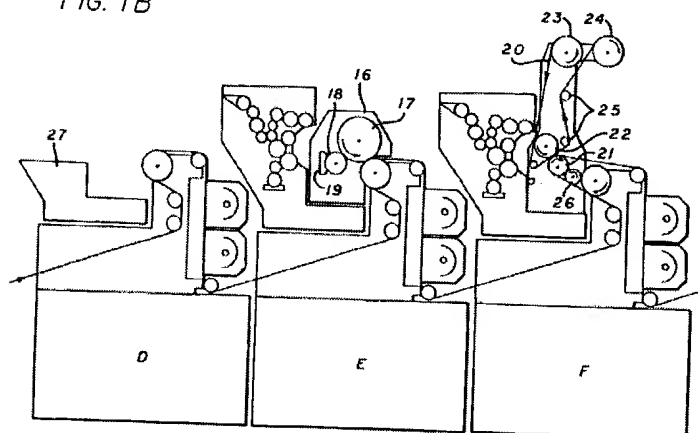


FIG. 1B



App. 1969). Thus, the "inclusion of material or article worked upon does not impart patentability to the claims." In *re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 (USPQ 458, 459 (CCPA 1963)). As such, claims 3-5 have been given no patentable weight.

Rasmussen et al., however, is silent as to the inclusion of a controlling portion for controlling the operation of each of the document creation, hot stamp transferring and transport portions of the apparatus. Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the apparatus of Rasmussen et al. with a controlling means motivated by the fact that it is well-established within the art, and especially so with regards to the modular apparatus such as that of Rasmussen et al., to utilize an over-arching control means to coordinate the operation of each of the printing/transferring modules and transport means. Pensavecchia et al. and Brunner teach examples of such art-recognized control schema. Pensavecchia et al. disclose that such control means enables maintenance of alignment and registration of the printing modules, allows feed back control which can eliminate, or at least reduce, the necessity of ongoing operator manipulation of the process (column 3, lines 59-63). Brunner likewise teaches that such a control means are able to sustain a uniform printing result and results in a regulating process which is more flexible and is kept adjustable by constant adaptation to changing print correlations over long periods of time (column 8, lines 4-9). The control means of Pensavecchia et al. (Figure 1) and Brunner (Figure 2) are illustrated below:

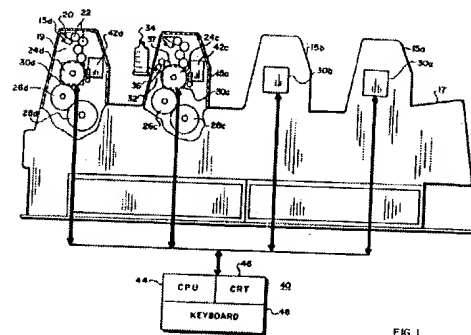
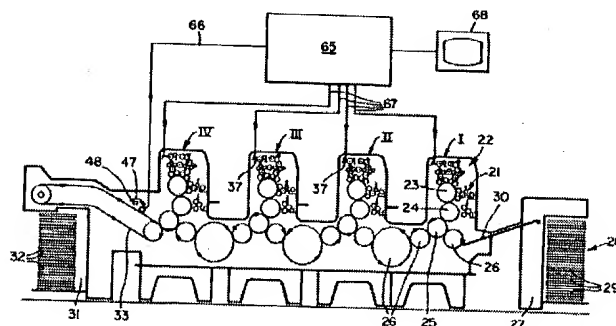


FIG. 1

Fig. 2.



Regarding applicant claim 2, Rasmussen et al. disclose that the hot stamp transferring portion (foil relief printer) F comprises a cassette, e.g. a cartridge (column 4, lines 28-38).

(2)

***Claim Rejections - 35 USC § 102***

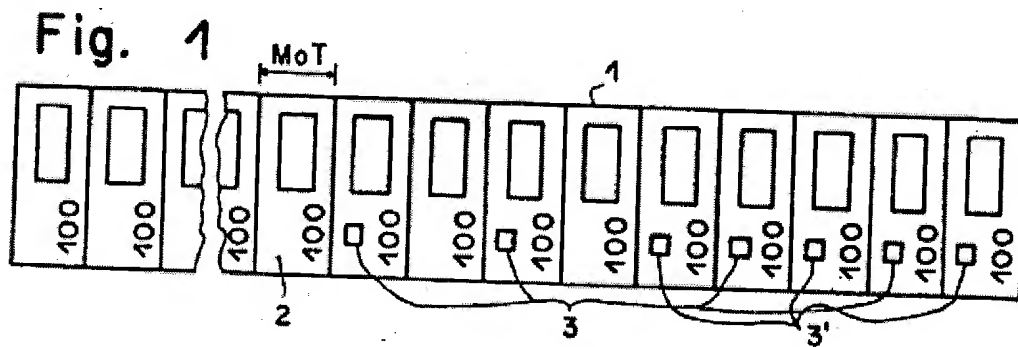
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,207,855 to Nyfeler et al.

Regarding applicant claim 6, Nyfeler et al. disclose an original document, i.e., a banknote, 1 with an original document indication, i.e., a holographic security stamp, 3, 3' applied by hot foil transfer (Figure 1; column 2, lines 12-64). The original document of Nyfeler et al. is illustrated below:



(3)

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (1), above, in further view of U.S. patent No. 5,207,855 to Nyfeler et al.

The references as combined in section (1), above, disclose a method and apparatus for the preparation of documents by printing and hot stamp transfer wherein the printing means for the printing step, hot foil transfer means for the hot foil transfer step and the transporting means are all controlled by a controlling means. They do not, however, specifically disclose that the

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document comprises an original document or that the hot stamp transferred image comprises an original document indication. Nyfeler et al., however, discloses a method and apparatus whereby an original document, i.e., a banknote, 1 is produced having an original document indication, i.e., a holographic security stamp, 3, 3' applied thereto by hot foil transfer (Figure 1; column 2, lines 12-64).

It would have therefore been obvious to one of ordinary skill in the art at the time of invention to provide the hot foil transfer device of Nyfeler et al. in the method and apparatus resulting from the references as combined in section (1), above (specifically substituting the Nyfeler et al. apparatus for the hot foil transfer means module F of Rasmussen et al.) motivated by the fact that Nyfeler et al. teaches that his hot foil transfer method and apparatus are specifically combinable with a document (banknote) printing means such that the printed banknotes 1 can be provided with an original document indication marking in the form of a hot transferred holograph stamp 3,3' (column 2, lines 12-31).

(4)

#### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such prior art includes References E-K on Form PTO-892.

(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.A. Lorengo, Primary Examiner

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November 27, 2004